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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,497	01/21/2004	Kaoru Iwato	Q79439	1130

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EXAMINER

SCHILLING, RICHARD L

ART UNIT PAPER NUMBER

1752

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,497

Applicant(s)

IWATO, KAORU

Examiner

Richard L. Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10-25-04; 6-08-05; 2-9-06; 1-24-04</u> | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 8 and 10-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 945264. EP 945264 (see particularly paragraphs 14-19,38,62-70,80,100-103,142-144; ex. 1, IR-24,25,26) discloses positive compositions comprising novolak resins and anionic IR absorbing dyes with sulfonium salt dissolution inhibitors as counter cations. The anionic dyes include those with two phenolic groups (ex. 1) or sulfo groups (IR-24-26). If EP 945264 does not anticipate the instant claims, then it would be at least be obvious to one skilled in the art to use ex.1 or IR-24-26 as the called for anionic dyes with the sulfonium cations in EP 945264.

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2. Claims 8 and 10-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2002-278050. JP'050 (see particularly the abstract, pages 34,35,38,39,60; dissolution inhibitors SA-26,27,24;SB-5,9,22;SI-5,8) discloses positive working compositions comprising novolak resins, IR absorbing dyes and sulfonium dissolution inhibitors with anions having hydroxyl or mercapto groups. If JP'050 does not anticipate the instant claims, then it would be at least obvious to one skilled in the art to use the disclosed sulfonium salts with OH or SH containing anions as the called for dissolution inhibitors.

3. Claims 8 and 10-16 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Iwato et al.'435. Iwato et al. (para. 19-22,46,69-74,140-154,199-201,260 ; ex. 41,49,66,71,79,96,101,109,126; claims 11,15-19) disclose the compositions set forth in the instant claims. The claims of 10/662,534 are now limited to ammonium salts which are nonelected in the instant application.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

4. Claims 8 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-278050 in view of Shimada et al.'411. JP'050 discloses positive working compositions comprising novolak resins, IR absorbing dyes and

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dissolution inhibitors of sulfonium salts with counter anions including those with SH or OH groups in addition to anionic groups. Shimada et al. (see particularly paragraphs 9-11,18-30,51-57) discloses that heat sensitive dissolution inhibitors of sulfonium salts containing counter anions with two or more anionic groups increase sensitivity by increasing light to heat conversion with IR dyes and thermal decomposition of the sulfonium dissolution inhibitors as compared to salts with one anionic group. Therefor, it would be obvious to one skilled in the art to use counter anions in the sulfonium salts of JP'050 with two or more anionic groups as in Shimada et al. in order to increase the thermal sensitivity of the materials in JP'050 by increasing the light to heat conversion efficiency and thermal decomposition of the sulfonium salt dissolution inhibitors.

4. Newman is cited of interest as disclosing compositions with novolak resins, IR absorbing dyes and sulfonium salt dissolution inhibitors.

Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 445 1752

